

This Page Is Inserted by IFW Operations
and is not a part of the Official Record

BEST AVAILABLE IMAGES

Defective images within this document are accurate representations of the original documents submitted by the applicant.

Defects in the images may include (but are not limited to):

- BLACK BORDERS
- TEXT CUT OFF AT TOP, BOTTOM OR SIDES
- FADED TEXT
- ILLEGIBLE TEXT
- SKEWED/SLANTED IMAGES
- COLORED PHOTOS
- BLACK OR VERY BLACK AND WHITE DARK PHOTOS
- GRAY SCALE DOCUMENTS

IMAGES ARE BEST AVAILABLE COPY.

**As rescanning documents *will not* correct images,
please do not report the images to the
Image Problem Mailbox.**



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/531,240	03/21/2000	Daja Phillips	074451.P112	7381

7590

08/10/2004

Judith A. Szepesi
BLAKELY SOKOLOFF TAYLOR & ZAFMAN LLP
12400 Wilshire Boulevard 7th Floor
Los Angeles, CA 90025

EXAMINER

HUYNH, KIM T

ART UNIT PAPER NUMBER

2112

DATE MAILED: 08/10/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/531,240

Applicant(s)

PHILLIPS ET AL.

Examiner

Kim T. Huynh

Art Unit

2112

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 June 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-40 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-40 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☒ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Art Unit: 2112

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this

Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-3, 5, 9, 11-13, 15, 17, 19, 23, 25-27, 29-31, 34-35, 37-40 are rejected under 35 U.S.C. 102(e) as being anticipated by Fukuda (Pub No. US20030012156)

As per claims 1, 15, Fukuda discloses a method of interfacing with a communication station, the method comprising:

- Receiving semi-structured data from a personal digital assistant (PDA) in a format native to the PDA; [0042-0043]
- Parsing the semi-structured data to identify a type of the semi-structured data if the type of the semi-structured data is destination data, the data being distinct from the semi-structured data and provided by a source other than the PDA. [0020], [0058-0059]

As per claim 2, Fukuda discloses wherein the PDA wirelessly transmits the semi-structured data, in a standard PDA format, to the communication station.[0043], [0058-0059]

As per claims 3, 17, Fukuda discloses wherein the data is a part of a document reproduced via a document reproduction system coupled to the communication station.[0058]

As per claims 5, 19, 23, Fukuda discloses the destination dictates how the data is sent. [0052-0054]

As per claims 9, 12, 26, Fukuda discloses wherein fetching information comprises:

- connecting to a network; [0049]
- connecting to the source; [0049]
- downloading the information from the source. [0049]

As per claims 13, 27, Fukuda discloses the search location is one or more of the an internal directory of users, an electronic white pages. ([0052], wherein address book implies directory.)

As per claim 29, Fukuda discloses a PDA interface for indicating to the PDA what actions were performed.[0049]

As per claims 30, 34, Fukuda discloses a method of sending data from a communication station, the method comprising:

- Receiving semi-structured data from a personal digital assistant (PDA) in a format native to the PDA; [0042-0043], [0058-0059]
- Parsing the semi-structured data to identify a type of the semi-structured data; [0020], [0058-0059]
- Acting on data in the manner indicated by the semi-structured data and a user, the data being distinct from the semi-structured data

Art Unit: 2112

and provided by a source other than the PDA; and [0042-0043],
[0058-0059]

- Returning a confirmation receipt to the PDA in a formative to the PDA, the confirmation receipt including a unique identification(ID) [0112]

As per claims 31, 35, Fukuda discloses wherein the uniqueID includes document/data sent, destination, and method of sending. [0112]

As per claim 37, Fukuda discloses the system further comprising: a user identification logic for identifying an owner of the PDA from whom the data is received.[0112]

As per claim 38, Fukuda discloses wherein the job ID further includes the identity of owner of the PDA. [0112-0114]

As per claim 39, Fukuda discloses a job history may be displayed to the user, when the user is identified.[0085]

As per claim 40, Fukuda discloses wherein a stored list of addresses used by the user in the past may be displayed to the user when the user is identified. [0112-0114]

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Art Unit: 2112

4. Claims 4, 6-8, 10, 14, 18, 20-22, 24, 28, 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fukuda (Pub No. US20030012156) in view of Shah et al. (Pub No US20030105821)

As per claims 4, 18, Fukuda discloses all the limitations as above except the method further comprising prompting a user to select one of the plurality of destinations, if the destination data indicates a plurality of destinations, wherein the data is sent to the selected destination.

However, Shah discloses for each designated recipient prompts the respective recipient for messaging information, receives the information from the recipient, and makes this information available to the sender via the server. The sender can select the desired messaging device by pointing and clicking with a mouse. [0060-0061]

It would have been obvious to one having ordinary skills in the art at the time the invention was made to incorporate Shah's teaching into Fukuda's system so as to provide for facilitating communication between a sending device and a receiving device. [0010]

As per claims 6, 20, 36, Shah discloses e-mailing the data if the destination is an e-mail address, and faxing the data if the destination is a fax number. [0060-0061], wherein email address inherently mail server, fax number inherently fax-server)

As per claim 7, Fukuda discloses the method further comprising fetching information from a source indicated by the semi-structured data, if the semi-structured data is source-location data; [0042-0043], [0058-0059]

Fukuda discloses all the limitations as above except the method further comprising prompting a user to select the destination for the information to be sent. However, Shah discloses for each designated recipient prompts the respective recipient for messaging information, receives the information from the recipient, and makes this information available to the sender via the server. The sender can select the desired messaging device by pointing and clicking with a mouse. [0060-0061]

It would have been obvious to one having ordinary skills in the art at the time the invention was made to incorporate Shah's teaching into Fukuda's system so as to provide for facilitating communication between a sending device and a receiving device. [0010]

As per claims 8, 22, Shah discloses the destination may be one or more of the following: a copy feature of the communication device, an e-mail address, and a fax number. [0060-0061], wherein email address inherently mail server, fax number inherently fax-server, copy feature inherently print)

As per claims 10, 24, Fukuda discloses the method further comprising fetching information from a search location indicated by the semi-structured data, if the semi-structured data is a search request [0024-0027], [0058-0059]

Fukuda discloses all the limitations as above except the method further comprising prompting a user to select the destination for the data based on the information. However, Shah discloses for each designated recipient prompts the respective recipient for messaging information, receives the information from the recipient, and makes this information available to the sender via the server. The sender can select the desired messaging device by pointing and clicking with a mouse. [0060-0061]

It would have been obvious to one having ordinary skills in the art at the time the invention was made to incorporate Shah's teaching into Fukuda's system so as to provide for facilitating communication between a sending device and a receiving device. [0010]

As per claims 14, 28, Shah discloses the method further comprising if the data is not recognized, prompting the user to identify a data type. [0066-0067]

As per claim 21, Fukuda discloses the apparatus further comprising:
A retrieving logic to receive the structured data if the semi-structured data is source-location data, the retrieving logic further to fetch information from a source indicated by the source-location data; and [0042-0043], [0058-0059]

Fukuda discloses all the limitations as above except the apparatus further comprising a user interface to prompt a user to select the destination for the fetched information, wherein the fetched information is sent to the selected destination. However, Shah discloses for each

Art Unit: 2112

designated recipient prompts the respective recipient for messaging information, receives the information from the recipient, and makes this information available to the sender via the server. The sender can select the desired messaging device by pointing and clicking with a mouse.

[0060-0061]

It would have been obvious to one having ordinary skills in the art at the time the invention was made to incorporate Shah's teaching into Fukuda's system so as to provide for facilitating communication between a sending device and a receiving device. [0010]

5. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Fukuda (Pub No. US20030012156) in view of Will (US Patent 5,825,353)

Fukuda discloses all the limitations as above except the communication interface receives the data over an infrared beam in a standard PDA format. However, Will discloses PDA transmits data from infrared emitter. (col.11, lines 32-35)

It would have been obvious to one having ordinary skills in the art at the time the invention was made to incorporate Will's teaching into Fukuda's system to have data receive over infrared beam so as doesn't allow correlation, communications directly to PDA. (col.12, line 40)

6. Claims 32-33 rejected under 35 U.S.C. 103(a) as being unpatentable over Fukuda (Pub No. US20030012156) in view of Frietas et al. (Pub No US20010047272)

Art Unit: 2112

Fukuda discloses all the limitations as above except the method further comprising if the semi-structured data includes the unique ID, retrieving data associated with the unique ID, and permitting the user to reuse the data. However, Frietas discloses the device support the ability to cache data locally for reference and reuse at a later time. The PDA cache can be updated by the user exchanging a cache data card on the PDA. [0025-0027]

It would have been obvious to one having ordinary skills in the art at the time the invention was made to incorporate Frietas' teaching into Fukuda's system so as to minimize transmitted information while maintaining the functionality of Banner Ads. [0006]

Response to Amendment

7. Applicant's amendment filed on 6/24/04 have been fully considered but are moot in view of the new ground(s) of rejection.

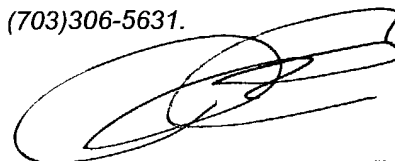
Conclusion

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kim Huynh whose telephone number is (703)305-5384 or via e-mail addressed to [kim.huynh3@uspto.gov]. The examiner can normally be reached on M-F 8:30AM-6:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Rinehart can be reached on (703) 305-4815 or via e-mail addressed to [mark.rinehart@uspto.gov]. The fax phone numbers for the organization where this application or proceeding is assigned are (703)872-9306 for regular communications and After Final communications.

Art Unit: 2112

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)306-5631.

A handwritten signature in black ink, appearing to read 'MARK H. RINEHART', enclosed within a large, loopy oval shape.

**MARK H. RINEHART
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100**

Kim Huynh

August 1, 2004